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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,716	01/26/2004	Louis R. Matson	88293-9001	8647
23510	7590	02/08/2006		
MICHAEL BEST & FRIEDRICH, LLP ONE SOUTH PINCKNEY STREET P O BOX 1806 MADISON, WI 53701			EXAMINER CHATTOPADHYAY, URMI	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/764,716	Applicant(s) MATSON, LOUIS R.	
	Examiner Urmi Chattopadhyay	Art Unit 3738	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. The first sentence of the specification regarding priority must be updated to indicate that this application is a continuation of 10/038,068 filed October 17, 2001, now abandoned, which is a continuation of 09/517,932 filed March 3, 2000, now abandoned, which claims benefit of 60/122,892 filed March 5, 1999.

### ***Information Disclosure Statement***

2. The Information Disclosure Statement filed January 26, 2004 has been entered. The references cited therein have been considered by the examiner. An initialed and signed copy of the IDS is enclosed.

### ***Specification***

3. The disclosure is objected to because of the following informality: on page 9, line 22, delete “)” after “deposition”. Appropriate correction is required.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “zone deposited” in claim 6 lacks antecedent basis in the specification.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 12, 13 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 6 and 18 are indefinite because “zone deposited” on lines 2-3 is not defined in the specification, and therefore, renders the claim unclear. Does it mean the silver is deposited on only one part of, many separate areas of, or one area at a time of the entire more noble metal layer? Applicant must clarify.

7. Claims 12 and 13 are indefinite because they require the additional limitation of (c), but are dependent on claim 7, which has only limitation (a). Where is limitation (b)?

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5, 7, 8, 10, 14, 15, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Haynes et al. (USPN 4,886,505 as cited in applicant’s IDS).

Haynes et al. discloses an antimicrobial surface with all the limitations of claim 1. See column 4, lines 51-56, column 5, lines 24-32 and Figure 10 for the requirements of part (a). See column 7, lines 33-55 for part (b) requirements.

Claim 2, see column 5, lines 40-42 for the metals as an alloy.

Claim 3, see column 7, lines 23-32 for the effectiveness of the silver concentration.

Claim 5, see Figure 10 for deposition of metals at separate sites.

Claims 7 and 14, see rejection for claim 1, supra.

Claims 8 and 15, see rejection for claim 2, supra.

Claims 10 and 17, see rejection for claim 5, supra.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 6, 9, 11, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes et al.

Haynes et al. discloses an antimicrobial surface with all the limitations of claims 1, 7 and 14, but is silent to the additional limitations of claims 6, 11, and 18 of the silver being zone deposited onto a portion of the more noble metal layer. Figure 2 shows the silver deposited entirely on the outside portion of the more noble metal layer, and Figure 10 shows the silver and more noble metal layer deposited on separate areas of the implant. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the implants of Figures 2 and 10 such that both layers contact the implant (as required by the respective independent claims), and there is a portion where the silver is deposited on the more noble metal layer in order to allow for greater ionization in certain areas than others, as needed.

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Claims 4, 9 and 16 are absent in showing a criticality of the molar ratio of silver to a more noble metal in the alloy being at most about 1:1. This ratio is taken as a design choice, and can vary according needs of the individual patient, such as the desired length of time over which silver ions are released. Therefore, it is obvious that Haynes et al. would meet this limitation as claimed.

12. Claims 12, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haynes et al. in view of Pratt et al. (USPN 4,849,223 as cited in applicant's IDS).

Haynes et al. discloses an antimicrobial surface with all the limitations of claims 7 and 14, but is silent to the additional limitations of the deposition of a corrosion mask on a portion of the deposited silver (claims 12, 19) and the polymer coating permeable to a physiologic electrolyte on a least a portion of the silver (claims 13, 20). Pratt et al. teaches an antimicrobial composition with a semi-permeable top coating of polymer in order to mask the silver from the deactivating effects of the body fluids in certain areas and control the release of silver ions in others. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Pratt et al. to modify the antimicrobial surface of Haynes et al. to include this polymer top coat in order to block the body fluids from the silver, and thus, prevent antimicrobial activity, in certain areas, while controlling the release of silver ions in other areas. See column 4, lines 8-12.

*Conclusion*

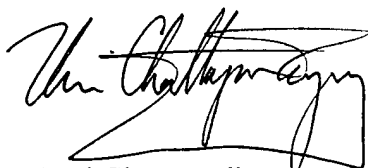
13. This is a continuation of applicant's earlier Application No. 10/038,068 and Application No. 09/517,932. All claims are drawn to the same invention claimed in the earlier applications and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urmi Chattopadhyay whose telephone number is (571) 272-4748. The examiner can normally be reached Monday through Thursday and every other Friday from 9:00am to 6:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Urmi Chattopadhyay

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David J. Isabella  
Primary Examiner